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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/008,820	11/13/2001	William George Alton	287108-00001	5667

7590

06/23/2003

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EXAMINER

PRONE, JASON D

ART UNIT

PAPER NUMBER

3724

DATE MAILED: 06/23/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/008,820

Applicant(s)

ALTON, WILLIAM GEORGE

Examiner

Jason Prone

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 8, 9, 12 and 15-19 is/are pending in the application.
- 4a) Of the above claim(s) 6, 7, 10, 11, 13 and 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8, 9, 12 and 15-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group II in Paper No. 7 is acknowledged.
2. Claims 6, 7, 10, 11, 13, and 14 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **with** traverse in Paper No. 7.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "that one or more groups have a different number of teeth that other groups on the blade", of claim 15, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

4. The disclosure is objected to because of the following informalities: On page 6 line 14, the phrase "cutting extension 22" should be replaced with "cutting extension 26".

Appropriate correction is required.

Claim Objections

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5. Claim 2 is objected to because of the following informalities: On line 4, the phrase "aligned with a another cutting extension" should be replaced with "aligned with another cutting extension".

6. Claim 19 is objected to because of the following informalities: On line 2, the phrase "each said cutting extension about the same width" should be replaced with "each said cutting extension has about the same width".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 2-5, 8, 9, 12, and 15-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. In regards to claim 2, on line 3, the phrase "each tooth in a group" is unclear. The term "group" was already defined on line 2 of claim 2. It is uncertain if both uses of the term "group(s)" are referring to the same or different material.

10. In regards to claim 2, on line 3, the phrase "a cutting extension" is unclear. The term "cutting extension" was already defined on line 5 of claim 1, from which claim 2 is dependent upon. It is uncertain if both uses of the term "cutting extension" are referring to the same or different material.

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11. Claim 2 recites the limitations "the sum" and "the widths of said cutting extensions" both on line 6. There is insufficient antecedent basis for these limitations in the claim.

12. Claim 3 recites the limitation "the outer side of the tooth body" on line 2. There is insufficient antecedent basis for this limitation in the claim.

13. Claim 4 recites the limitation "the same width" on line 2. There is insufficient antecedent basis for this limitation in the claim.

14. In regards to claim 5, on line 3, the phrase "a cutting extension" is unclear. The term "cutting extension" was already defined on line 5 of claim 1, from which claim 5 is dependent upon. It is uncertain if both uses of the term "cutting extension" are referring to the same or different material.

15. In regards to claim 5, on line 4, the phrase "cutting extension having a width" is unclear. That the "cutting extension has a width" was already defined on line 6 of claim 2, from which claim 5 is dependent upon. It is uncertain if both uses of the term "width" are referring to the same or different material.

16. Claim 5 recites the limitation "the number" on line 5. There is insufficient antecedent basis for this limitation in the claim.

17. In regards to claim 8, on line 4, the phrase "a cutting extension" is unclear. The term "cutting extension" was already defined on line 5 of claim 1, from which claim 8 is dependent upon. It is uncertain if both uses of the term "cutting extension" are referring to the same or different material.

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18. In regards to claim 8, on line 4, the phrase "cutting extension with a width" is unclear. That the "cutting extension has a width" was already defined on line 6 of claim 2, from which claim 8 is dependent upon. It is uncertain if both uses of the term "width" are referring to the same or different material.

19. In regards to claim 8, on line 11, the phrase "opposite the tooth body side aid first cutting extension extends towards" is unclear and should be re-written for clarity.

20. Claim 12 recites the limitations "the sum", "the widths of said cutting extensions" both on line 4, and "the number" on line 6. There is insufficient antecedent basis for these limitations in the claim.

21. In regards to claim 15, it unclear how one or more groups can have a different number of teeth. In order to have a saw blade with groups containing a different number of teeth, the width and locations of the cutting extensions would not correspond between the two different groups. Therefore, it is unclear from Figures 4B, 5B, and 6B how any other number of teeth, besides 4, would work.

22. Claim 18 recites the limitations "the sum", "the widths of said cutting extensions" both on line 4, and "the number" on line 6. There is insufficient antecedent basis for these limitations in the claim.

Claim Rejections - 35 USC § 102

23. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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24. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Kullmann et al. (4,640,172).

'172 discloses the same invention including a band saw body (1) having a centerline (Fig. 1), a plurality of unset teeth (3) disposed on the band saw body (Fig. 1), that each tooth has a body with a width and a uniform height (5), that at least some of the teeth have cutting extensions (t_1) extending above the height of the tooth body (Fig. 1), and that each cutting extension has two outer sides (8).

Allowable Subject Matter

25. Claims 2-5, 8, 9, 12, and 15-19 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

26. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Barry, Harris, Oakes, Foerster, Anderson, Grassmann, Kawakami et al., Kullman ('763), Hayden, Sr., Tsujimoto, Kobayashi et al., Vöge, Hopper et al., Neil, and Allegri

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Prone whose telephone number is 703-605-4287. The examiner can normally be reached on 7:30-5:00, Mon - (every other) Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 703-308-1082. In lieu of mailing, it is encouraged that all formal responses be faxed to 703-872-9302.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

A handwritten signature, possibly reading 'JP', consisting of a large, stylized capital 'J' followed by a capital 'P'.

JP
June 9, 2003

A handwritten signature in cursive script, likely belonging to Allan N. Shoap.

Allan N. Shoap
Supervisory Patent Examiner
Group 3700